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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,764	06/22/2000	Roy Martin	1519.016	2537

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/05/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-8

Office Action Summary

Application No.

09/603,764

Applicant(s)

Examiner

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 3/15/02 AS AMENDMENTS A

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above claim(s) 7-16 is/are withdrawn from consideration.

☐ Claim(s) is/are allowed.

☒ Claim(s) 1-6 is/are rejected.

☐ Claim(s) is/are objected to.

☐ Claim(s) are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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FINAL REJECTION

Election/Restriction

1. Newly submitted claims 10-16 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: New claims 10-16 are independent and distinct from elected claims 1-6 for a number of reasons. Some of these reasons are: 1) Elected claims 1-6 require the use of a hydrogen peroxide donor or a peroxycarboxylic acid whereas claims 10-16 encompass a broader oxidizer source (i.e. anionic oxidizer), and 2) claims 1-6 require the presence of an electrolyte whereas claims 10-16 do not.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10-16 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Zinkan et al. U.S. Patent Number 5,382,367 and Coughlin et al. U.S. Patent Number 5,800,732.

Zinkan et al teaches a method of treating cooling water system to prevent and control the corrosion and buildup of scales in said systems. The method comprises using low concentrations of hydrogen peroxide, see the abstract. Applicant's claims are deemed to be anticipated over Example III and Table I.

Coughlin et al teaches a concentrated all-in-one treatment compositions for cooling water systems. The compositions contain high concentrations of peroxide (such as hydrogen peroxide, alkali metal peroxides, organic peroxides (e.g. peracetic acid)), peroxide stabilizer (such as a phosphonate), polyhydric alcohol, and optional additional metal corrosion inhibitors, see the abstract, and column 1, lines 55-67. Applicant's claims are deemed to be anticipated over Example 2 wherein the all-in-one treatment is added to the water in a cooling tower such that the peroxide is in very low concentration.

4. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ono U.S. Patent Number 5,736,097.

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Ono teaches method of preventing pitting corrosion of copper or copper alloy water systems by the addition of low concentrations of peroxides (e.g hydrogen peroxide, peroxocarbonates, peroxyacetates etc.), see the abstract and column 2, lines 7-47. Applicant's claims are deemed to be anticipated over the examples.

5. Claims 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by LaZonby et al U.S. Patent Number 5,658,467.

LaZonby et al teaches method and compositions for inhibiting growth of microorganisms by the adding sufficient amounts of peracetic acid and a non-oxidizing biocide to industrial process waters systems. Applicant's claims are deemed to be anticipated over Example 7.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coughlin et al. U.S. Patent Number 5,800,732 and Ono U.S. Patent Number 5,736,097.

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Coughlin et al and Ono have been described above. Coughlin et al and Ono both differ from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to where a peroxycarboxylic acid is used in leu of hydrogen peroxide.

It would have been obvious one having ordinary skill in the art to use the disclosure of Coughlin et al at column 1, lines 63-67, and Ono at column 2, lines 14-19, as motivation to actually use a peroxycarboxylic acid in leu of hydrogen peroxide in their treatment of cooling water systems.

8. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woyciesjes U.S. Patent Number 5,000,866 and Hirozawa et al. U.S. Patent Number 4,234,440.

Woyciesjes and Hirozawa et al both teaches antifreeze compositions that are buffered with electrolytes wherein said buffered compositions inhibit the corrosion of metals that they come in contact with. Both references further disclose that optional known anti-corrosion agents may be added to their antifreeze compositions, see the abstract, examples, and claims of both patents. Furthermore see, column 4, lines 3-25 of Hirozawa et al and column 10, lines 39-40 of Woyciesjes.

Woyciesjes and Hirozawa et al both differ from applicant's claimed invention in that they do not directly teach (i.e. by way of an example) the further addition of hydrogen peroxide as an additional anti-corrosion agent to their anti-freeze compositions. It would have been obvious to one having ordinary skill in the art to use the broad disclosure of Woyciesjes and Hirozawa et al

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as motivation to actually add hydrogen peroxide as an additional metal anti-corrosion inhibitor, since both references individually directly disclose the hydrogen peroxide is known in the art to be an effective corrosion inhibitor, see column 1, lines 15-39 of Woyciesjes and column 1, lines 40-57 of Hirozawa et al..

Information Disclosure Statement

9. The information disclosure statement filed 11/30/01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

10. The information disclosure statement filed 11/30/01 also fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56© most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

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Response to Arguments

11. Applicant's arguments filed 3/15/02 with amendment A have been fully considered but are not persuasive to put the application in condition for allowance for the reasons given above.

Additional examiner comments are found below.

The fact that none of the applied prior-art directly states that when their compositions are applied to metal surfaces, corrosion is inhibited by inducing passivation of the metal surface is deemed to be moot since such a limitation is not a method step itself but is rather a "mechanisms" by which applicant assert his methods works by. All the applied prior-art directly teaches or suggests a method of applying an oxidizer with an electrolyte to a metal surface that has the effect of limiting corrosion of the metal surface along with any other addition effect, such as biocidal effects. Applicant has thus not invented a new method of corrosion inhibiting. At most applicant may have discovered a "new property" (i.e. inducing passivation of the metal surface) that results when hydrogen peroxide donors or peroxyacids are used in combination with electrolytes in methods of contacting metal surfaces. Even if the processes of the applied prior-art do not induce passivation of the metal surface such is deemed to be moot since the applied prior-art teaches or suggests all of applicant active method steps. Furthermore, the fact that many of the applied prior-art references use other components in combination with hydrogen peroxide or peroxyacid in their methods, is deemed to be moot since all of applicant's claims use the most open claim language of "comprising".

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Applicant's assertion that Coughlin et al discloses that Zinkan et al employs separate addition of hydrogen peroxide and corrosion inhibitor and dispersant (see column 1, lines 15-25) is noted. Nevertheless, the Examiner rejects Coughlin et al's interpretation of the Zinkan et al. Patent, since Zinkan et al clearly teaches the use of compositions that comprise hydrogen peroxide, corrosion inhibitor and dispersant in admixture, see the examples.

Applicant should note that the Examiner did not apply the Woyciesjes patent in combination with the Hirozawa et al patent. These two patents are applied individually over applicant's claims 1-3. If the examiner has wanted to apply them in combination the heading of the rejection would of been either: 1) Woyciesjes U.S. Patent Number 5,000,866 in combination with Hirozawa et al. U.S. Patent Number 4,234,440, or 2) Woyciesjes U.S. Patent Number 5,000,866 in view of Hirozawa et al. U.S. Patent Number 4,234,440.

Finally, applicant's response did not contain any copies of the references for the IDS filed 11/26/01. As such, the problems with the IDS remains.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

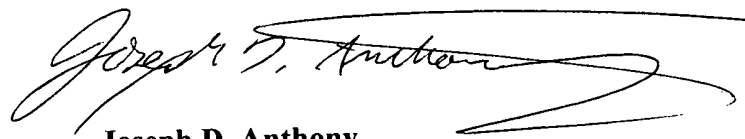
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (703) 308-0446. This examiner can normally be reached on Monday through Thursday from 7:35 a.m. to 6:00 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The group **(non-after final)** FAX machine number is (703) 872-9310. The group **(after final)** FAX machine number is (703) 872-9311. Unofficial correspondence transmitted by FAX must be marked "DRAFT". All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0651. The receptionist is located on the 8th floor of Crystal Plaza 3 (e.g. CP-3) and will be the welcome point for all visitors to the building.



Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

6/2/02